

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/818,483 Confirmation No.: 9569
Applicant: E. Brian Finkelstein, et al.
Title: NEGOTIATED RIGHTS EXCHANGE
Filed: March 27, 2001
Art Unit: 3692
Examiner: Lindsay Maguire

Atty. Docket: 00-8201
Customer No. 63710

REQUEST FOR CORRECTION OF OFFICE ACTION PURSUANT TO MPEP § 710.06

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to MPEP § 710.06, Applicant calls to the attention of the Office to errors in the Office's paper of September 7, 2007, and requests (a) that the Office reissue the paper in corrected and completed form, and (b) reset the period for reply to one month from the date of the reissued Office paper. If no complete Restriction Requirement can be stated within the requirements of MPEP Chapter 800, Applicant requests that the application be examined.

MPEP § 710.06 was recently amended to provide as follows, in relevant part:

710.06 Situations When Reply Period Is Reset or Restarted

Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. ... The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

...

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

Kindly provide a corrected Action that addresses all of the following issues, or examines the relevant claims:

1. What legal provision is thought to apply? The Office Action identifies no statute or 37 C.F.R. Rule or any other law or rule having force of law.¹ Unless some law is identified, an applicant cannot do anything to bring the application into conformance with that law. This failure to identify any legal basis is an error that affects Applicant's ability to reply.
2. 35 U.S.C. § 121 only authorizes restriction in cases where "two or more independent and distinct inventions are claimed in one application.". The Office Action itself directly concedes that only one invention is now claimed. Restriction among two inventions is well established and understood; restriction between something and nothing is a novel legal concept that is not understood. This incongruity and mismatch between all known authority granted to the Office by Congress and the Office Action is an error that affects Applicant's ability to reply.
3. MPEP § 803 states that restriction is only authorized where the Office action makes two showings (emphasis added):

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - § 806.05(i)) and
- (2) There must be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §806.04(a)-(j), §808.01(a) and §808.02).

MPEP § 803 clarifies (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The Office Action uses none of the standard form paragraphs. The Office Action is **dead silent** on any showing that the inventions are "independent and distinct," and **dead silent** on any showing of "serious" search burden. No restriction requirement is stated

¹ Recent Executive Orders of the President, the Final Bulletin for Agency Good Guidance Practices, and related Presidential instructions have restated the long-standing principle that informal guidance documents, such as the MPEP, are only binding on agencies themselves, and may not create obligations on the public. Thus, the MPEP is not a document with "force of law" that would meet this request. Executive Order 12,866, 58 Fed. Reg. 51735-51744, <http://www.whitehouse.gov/omb/inforeg/eo12866.pdf> (October 4, 1993); Executive Order 13,422, 72 Fed. Reg. 3432, http://www.whitehouse.gov/omb/inforeg/eo12866/ft_notice_eo12866_012307.pdf (Jan. 25, 2007); OMB Memorandum M-07-07, "Final Bulletin for Agency Good Guidance Practices," <http://www.whitehouse.gov/omb/memoranda/fy2007/m07-07.pdf> (January 18, 2007); and OMB Memorandum M-07-13, "Implementation of Executive Order 13422 (amending Executive Order 12866) and the OMB Bulletin on Good Guidance Practices," <http://www.whitehouse.gov/omb/memoranda/fy2007/m07-13.pdf> (April 25, 2007).

sufficiently to require any action from Applicant. The failure of the Examiner to follow recognizable procedures and the failure to set forth any showings on the mandatory *prima facie* elements of any restriction requirement are two errors that affect Applicant's ability to reply.

4. Are the claims as now pending truly "independent and distinct" from those pending earlier, or are they merely the same invention (in a restriction sense) framed in different words? If the claims are now directed to a different invention, is this merely amendment in ordinary course that does not raise a question of a separate "invention" in a restriction sense? What do the precise words of the claim mean – the paraphrase in the Office Action is hopelessly garbled and inaccurate – was any genuine thought exerted in preparing the September 7, 2007 paper? The imprecision in the Office Action is an error that affects Applicant's ability to reply.
5. These questions were raised in a voice mail left for Examiner Maguire on Thursday morning, October 4, 2007. That phone call was not returned within one business day. This failure of the Examiner to comply with Office policy on return of phone calls is an error that affects Applicant's ability to reply.

Applicant requests a corrected Office Action, and if no such Action can be prepared, that the application be examined in due course, in accordance with written rules. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 00-8201.

Respectfully submitted,

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Dated: October 8, 2007

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